contact relationship with the surface of the tissue sample. It is the Examiner's position that Figure 8 of Harris shows a window in pressure contact with the tissue sample. However, Figure 8 of Harris actually shows a spigot providing a cup in which a space appears to be present between the surface of the tissue (72) and lens system (82). Moreover, Harris states at column 6, lines 41-46, that a "cleansing fluid [is] to be supplied so as to bathe the area to be viewed to clear any obstructing debris from the optic path", see also column 6, lines 55-65. Clearly this teaches away from a pressure contact relationship of the window to the tissue because if tissue (72) were in a pressure contact relationship against any window this would prevent a cleansing fluid from being able to clear debris obstructing viewing along the optical path through such window to the tissue. Thus, Harris does not describe each and every element of Claims 27 and 34, and withdrawal of the 35 U.S.C. §102(b) rejection of Claims 27 and 34, and respective dependent Claims 28-31, is requested.

Claims 32 and 35-43 were rejected under 35 U.S.C. §103(a) as unpatentable over the Koester Applied Optics Article in view of Zavislan (U.S. Patent No. 5,788,639). The Zavislan patent issued from one of the parent Applications, Serial No. 08/650,684, to the present Continuation Application No. 09/579,599, though Continuation Application Serial No. 09/001,016, now U.S. Patent No. 6,263,233. The present Continuation Application, and Zavislan Patent Nos. 5,788,639 and 6,263,233 are owned by the same assignee. Thus, neither the Zavislan Patent No. 5,788,639, nor Patent No. 6,263,233, is a proper 35 U.S.C. §103(a) reference. Accordingly, the rejection of Claims 32 and 35-43 under 35 U.S.C. §103(a) is not proper and should be withdrawn.

A petition for a three month extension of time is enclosed with a check for the required $460.00 fee.

Respectfully submitted,

Dated: April 9, 2002

Kenneth J. LuKacher
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Enclosed: Copy of Second Preliminary Amendment with Copy of Returned Receipt Postcard;
Petition for Extension of Time (in duplicate) with a check for $460.00;
Change of Attorney Address in Application; and
Certificate of Mailing by Express Mail, Express Mail No. EL 852883997 US.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Zavislan et al.

Serial No.: 09/579,599

Filed: May 26, 2000

For: MICROSCOPIC IMAGING APPARATUS AND METHOD (as amended)

Examiner: Unknown Art Unit: 3739

Atty Docket: ML-0362C2

Asst. Commissioner of Patents
Washington, D.C. 20231

SECOND PRELIMINARY AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Please amend the above-identified application as follows:

In the Specification:

Please rewrite the paragraph on page 1, beginning on line 3, and ending at line 5 as follows:

This application is a continuation of application Serial No. 09/001,016 filed December 30, 1997, now U.S. Patent No. 6,263,233, which is a continuation of application Serial No. 08/650,684 filed May 20, 1996, now U.S. Patent No. 5,788,639, which claims the priority benefit of co-pending provisional application, Serial No. 60/001,141, filed July 13, 1995.

In the Claims:

Please rewrite Claims 27 and 34 as follows:

27. (amended) A microscopic imaging apparatus for imaging tissue samples for pathological applications through an objective lens, said apparatus comprising:

an objective lens;

a window having a surface capable of being in a pressure contact relationship with the surface of said tissue sample in which said window is in optical communication with said objective lens; and

a housing capable of being handheld having at least said objective lens and said window.

34. (amended) A system for imaging and diagnosing a tissue sample for pathological applications comprising:

an objective lens;

a window having a surface capable of being in a pressure contact relationship with the surface of said tissue sample;

a housing capable of being handheld having at least said objective lens and said window;

an illumination beam which is focused by said objective lens through said window to said tissue sample, in which said objective lens receives returned light from said tissue sample representing a tissue section; and

means for displaying said tissue section to diagnose abnormalities in said tissue sample.

Please cancel Claim 32 without prejudice.

Remarks

Entry of the amended claims is respectfully requested.

The specification is amended to update the status of a referenced application.

A Fourth Supplemental Information Disclosure Statement is enclosed.

Respectfully submitted,

Dated: July 12, 2001

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Certificate of Mailing by First Class Mail

I certify that this document is being deposited on July 12, 2001 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Signature of Person Mailing Correspondence

Tammy S. Moynihan

Typed or Printed Name of Person Mailing Correspondence

Appendix

Marked-up version of the specification and claims as presented in the attached Second Preliminary Amendment.

Amended paragraph on page 1 of the specification beginning on line 3, and ending at line 5:

This application is a continuation of application Serial No. 09/001,016 filed December 30, 1997, now [pending] U.S. Patent No. 6,263,233, which is a continuation of application Serial No. 08/650,684 filed May 20, 1996, now U.S. Patent No. 5,788,639, which claims the priority benefit of co-pending provisional application, Serial No. 60/001,141, filed July 13, 1995.

27. (amended) A microscopic imaging apparatus for imaging tissue samples for pathological applications through an objective lens, said apparatus comprising:

an objective lens; [and]

a window having a surface capable of being in a pressure contact relationship with the surface of said tissue sample in which said window is in optical communication with said objective lens; and

a housing capable of being handheld having at least said objective lens and said window.

34. (amended) A system for imaging and diagnosing a tissue sample for pathological applications comprising:

an objective lens;

a window having a surface capable of being in a pressure contact relationship with the surface of said tissue sample;

a housing capable of being handheld having at least said objective lens and said window;

an illumination beam which is focused by said objective lens through said window to said tissue sample, in which said objective lens receives returned light from said tissue sample representing a tissue section; and

means for displaying said tissue section to diagnose abnormalities in said tissue sample.